

### REMARKS

Claims 58-77 are currently pending in the subject application and are presently under consideration. Claims 58 and 63 have been amended as shown on pg. 2 of the Reply. A listing of claims is shown on pp. 2-5 of the Reply. The below comments present in greater detail distinctive features of applicants' claimed invention telephonically conveyed to Examiner on September 10, 2007.

Accordingly, favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

#### **I. Rejection of Claims 58-77 Under 35 U.S.C. §102(e)**

Claims 58-77 stand rejected under 35 U.S.C. §102(e) as being anticipated by Wilf (U.S. 2001/0049826). It is respectfully submitted that this rejection be withdrawn for at least the following reasons. Wilf does not anticipate each and every element as set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim*. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim*. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

The claimed subject matter relates to decoding audio, video and closed captioning data associated with a communication. To this end, a decoding system can decode data and convert the data into a form suitable for a keyword generating system. A search engine can then use the keywords for a search, and the results of the search can be displayed to a viewer. In particular, amended independent claim 58 recites *a decoding system that decodes the image, audio and closed captioning data and converts the image, audio and closed captioning data to a format suitable for use by a keyword generating system*. Independent claims 69 and 77 recite similar limitations. It is respectfully requested that this rejection be withdrawn for at least the following reasons. The cited reference fails to disclose or suggest the subject claims.

Wilf relates to a system that decodes audio and video data. The decoded data is stored remotely on a video search server, and a home user can then search the server database to locate a program of interest (*See* Paragraph 0043). Examiner contends that the cited reference discloses the claimed aspect of applicants' invention at Paragraph 0015 (*See* Office Action dated August 10, 2007, pg. 3). Applicants' representative respectfully disagrees with such contention.

The cited passage relates to viewing television using picture-in-picture (PIP) technology, while allowing a user to browse the Internet within the same screen. No conversion of data takes place; rather, a user must *manually* enter search terms into the web browser based on a information he or she views. This differs from applicants' claimed subject matter, in which *a decoding system ... converts the image, audio and closed captioning data to a format suitable for use by a keyword generating system.*

Moreover, independent claim 58 (and similarly independent claims 69 and 77) also recites *an output component that displays the results from the search component concurrently with displaying an output corresponding to the broadcasting image, audio and closed captioning data.* Examiner contends that the cited reference discloses the claimed subject matter at Paragraph 0016 (*See* Office Action dated August 10, 2007, pg. 3). Applicants' representative respectfully disagrees with such contention.

Paragraph 0016 of Wilf relates to televisions with built-in Internet browsing capabilities, as well as computers with television viewing capability. The cited passage does not relate to displaying results from a search, but instead relates to integration of televisions and computers. Furthermore, the indicated passage is also silent with respect to displaying search results, broadcast image data, audio data and closed-captioning data concurrently. Therefore, the cited reference does not disclose or suggest *an output component that displays the results from the search component concurrently with displaying an output corresponding to the broadcasting image, audio and closed captioning data*, as recited in the subject claims.

Additionally, Wilf fails to disclose or suggest *the output component sends the results continually to a user and plays the results while additional results are being sent*, as dependent claim 63 recites. Examiner argues that Wilf discloses the subject claim at Paragraphs 0069 and 0072. Applicants' representative avers to the contrary.

The cited passages are silent with respect to sending any type of information continually, as well as playing results while additional result are being sent. The indicated passages relate to

storing information that relates to program data on a server. As a result, the indicated passages fail to disclose or suggest *the output component sends the results continually to a user and plays the results while additional results are being sent*, as claimed.

It is also noted that the standard by which anticipation is to be measured is ***strict identity*** between the cited document and the invention as claimed, not mere equivalence or similarity (*See Richardson* at 9 USPQ2d 1913, 1920). This means that in order to establish anticipation under 35 U.S.C. §102, the single document cited must not only expressly or inherently describe each and every limitation set forth in the patent claim, but also the ***identical invention*** must be shown in as complete detail as is contained in the claim. As noted *supra*, Wilf fails to provide an invention identical to that recited in the subject claims.

In view of the foregoing, it is readily apparent that Wilf fails to disclose each and every element of independent claims 58, 69 and 77 (and associated dependent claims 59-68 and 70-76). Therefore, it is respectfully requested that the rejection of independent claims 58, 69 and 77, as well as claims 59-68 and 70-76, which depend therefrom, be withdrawn.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP122USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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